REMARKS

Claims 1-51 were pending in this application.

Claims 1-38 have been rejected.

Claims 39-51 have been allowed.

Claims 1, 5, 14, 18, 26, 30, 35, and 36 have been amended as shown above.

Claims 1-51 remain pending in this application.

Reconsideration and full allowance of Claims 1-51 are respectfully requested.

I.   ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 39-51 are allowable. These claims have not been amended and therefore remain in condition for allowance.

II.   OBJECTION TO SPECIFICATION

The Office Action objects to an informality in the specification. The Applicants have amended the specification to correct the noted informality. Accordingly, the Applicants respectfully request withdrawal of the objection to the specification.

III.   REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-7, 9-16, 18-24, and 26-37 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,740,163 to Herve ("*Herve*"). This rejection is respectfully traversed.

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A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP § 2131; In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)*). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP § 2131; In re Donohue, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)*).

The Office Action fails to establish that *Herve* anticipates directing an encoder to encode data in a particular mode or encoding data in a particular mode "in response to" sensing data received in that particular mode at a "decoder" as recited in Claims 1, 9, 18, and 26.

Herve recites a "dual-mode ISDN/STN videophone terminal" capable of being connected to an integrated services digital network (ISDN) or a switched telephone network (STN). (*Abstract; Col. 1, Lines 25-27*). The terminal includes ISDN codecs 6, 13 and STN codecs 24, 25. (*Figure 1*). The ISDN codecs 6, 13 include audio and video encoders and decoders 31-32 and 35-36, and the STN codecs 24, 25 include STN audio and video encoders and decoders 33-34 and 37-38. (*Abstract; Figure 2*). A switch 28 is used to select either ISDN or STN mode. (*Col. 3, Lines 58-65*).

Herve simply recites that different kinds of audio encoders and decoders and different kinds of video encoders and decoders may be used in the terminal. However, *Herve* lacks any mention of selecting one of the encoders based on the type of data received at the decoders. For example, *Herve* lacks any mention of selecting the ISDN audio encoder 31 when the ISDN audio decoder 32 receives ISDN data. *Herve* also lacks any mention of selecting the STN audio

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encoder 33 when the STN audio decoder 34 receives STN data.

Claims 1, 9, 18, and 26 specifically recite directing an encoder to encode data in a particular mode or encoding data in a particular mode "in response to" sensing data received in that particular mode at a decoder. *Herve* lacks any mention of encoding data in a particular mode based on sensing the type of data received at a decoder. As a result, *Herve* fails to anticipate all elements of Claims 1, 9, 18, and 26.

The Office Action cites various portions of *Herve* as allegedly disclosing these elements of Claims 1, 9, 18, and 26. For example, the Office Action cites column 3, line 63 through column 4, line 5 of *Herve* as allegedly disclosing the "sensing" of "data received in [a] custom mode at [a] decoder." (*Office Action, Page 12, Second paragraph*). However, the cited portion of *Herve* contains absolutely no mention of sensing the type of data received at a decoder. The cited portion of *Herve* recites that the switch 28 is used to select either ISDN mode or STN mode for the terminal (*Col. 3, Lines 62-64*), an STN signaling unit 29 controls a viseophone call (*Col. 3, Line 66 – Col. 4, Line 1*), and a RAM 30 supports answering and recording functions. (*Col. 4, Lines 1-5*). Nothing here indicates that the terminal of *Herve* "senses" a "mode" for data received at a "decoder" and then directs an "encoder" to encode data using that "mode." At most, this portion of *Herve* simply indicates that the setting of the switch 28 controls which encoders and decoders (ISDN or STN) are used. This portion of *Herve* lacks any mention that the switch 28 is set to one of the modes based on "sensing" the type of data received at a "decoder" as recited in Claims 1, 9, 18, and 26.

The Office Action also asserts that *Herve* discloses decoding information in one mode

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(an "RTC" mode) "when (or in response to) sensing/detecting/receiving the data in the RTC mode." (*Office Action, Page 13, First paragraph*). First, the Office Action fails to identify any portion of *Herve* supporting these assertions. In particular, the Office Action fails to identify where *Herve* discloses using a particular mode at an encoder in response to sensing, detecting, or receiving data encoded in that mode. Second, the Office Action fails to identify any portion of *Herve* indicating that the RTC mode is selected in response to "sensing" information received at a "decoder." As shown in Figure 1 of *Herve*, a management system 18 (which controls switch 28) is coupled to the multiplexers/demultiplexers 14, 26. The management system 18 of *Herve* is not connected to the codecs 6, 13, 24, 25 of *Herve*. The Office Action fails to explain how the management system 18 of *Herve* is capable of "sensing" the type of data received at a decoder 32, 34, 36, 38.

Herve lacks any mention of "sensing" data in one mode at a "decoder" and then directing an "encoder" to encode data in that mode as recited in Claims 1, 9, and 18. *Herve* also lacks any mention of "sensing" data in one mode at a "decoder" and then encoding data in that mode as recited in Claim 26. For these reasons, *Herve* does not anticipate the Applicants' invention as recited in Claims 1, 9, 18, and 26 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1-7, 9-16, 18-24, and 26-37.

IV.   REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 8, 17, 25, and 38 under 35 U.S.C. § 103(a) as being

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unpatentable over *Herve* in view of U.S. Patent No. 6,721,916 to Agazzi ("*Agazzi*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second,

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there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

As described above in Section III, Claims 1, 9, 18, and 26 are patentable. As a result, Claims 8, 17, 25, and 38 are patentable due to their dependence from allowable base claims.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 8, 17, 25, and 38.

V.   CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

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SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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